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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/084,336

02/28/2002

Dieter Kerner

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EXAMINER

ZIMMER, MARC S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

04/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/084,336

Applicant(s)

KERNER ET AL.

Examiner

MARC S. ZIMMER

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1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 8 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 8 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis in claim 15 for the mention of a cyclic polysiloxane in claim 8.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mangold et al., JP 2000-169132 in view of the teachings taken from Chapter 6 of the volume entitled *Handbook of Fillers, 2nd Edition* authored/edited by Wypych, Herzig, U.S. Patent # 4,101,499, Penneck, U.S. Patent # 4,001,128, and Cyprien Guy et al., U.S. Patent # 4,886,661 for the reasons established earlier.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hemme et al., U.S. patent Application Publication No. 2002/0018741 in view of the teachings taken from Chapter 6 of the volume entitled *Handbook of Fillers, 2nd Edition* authored/edited by Wypych, Herzig, U.S. Patent # 4,101,499, Penneck, U.S. Patent #

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4,001,128, and Cyprien Guy et al., U.S. Patent # 4,886,661 for the reasons established earlier.

Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mangold et al., JP 2000-169132 in view of the teachings taken from Chapter 6 of the volume entitled *Handbook of Fillers, 2nd Edition* authored/edited by Wypych, Herzig, U.S. Patent # 4,101,499, Penneck, U.S. Patent # 4,001,128, and Cyprien Guy et al., U.S. Patent # 4,886,661 as applied to claims 13-16 above and also in view of Lentz, U.S. Patent # 3,122,520 for the reasons established earlier.

Applicant acknowledges that the aforementioned supporting references disclose the employment of the claimed organosilicon compounds as surface modification agents for metal(loid) oxides but indicates that there is no impetus to combine the references because, for example, Mangold teaches doped metal oxides that have utility in inkjet paper manufacture but none of the supporting references speak to this application. They appear to insist on ignoring the fact that Mangold also contemplates blending the doped metal oxides into polymer materials. The Examiner has stated that it is in these instances that it would be obvious to treat the doped metal oxide with an organosilicon compound per the suggestion of Wypych, Herzig, Penneck, and many, many others as the organosilicon compound serves to compatibilize the filler with the host matrix into which it is mixed which, in turn, results in the improvement of various properties, an improvement that Applicants have alleged is unexpected. That the

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primary reference, itself, doesn't mention treatment of the inventive particles may almost certainly be attributed to the fact that the insertion of said particles into a polymer material is only given cursory mention.

Applicants also continue to maintain that the Examiner's assertions that the unexpected properties are, in actuality, expected is rooted in mere speculation despite the fact that the Examiner furnished numerous references verifying that enhancements in these properties are predicted insofar as they all relate to the compatibility of the filler with the polymer material and the concomitant reductions in filler aggregation. For the Applicant to persist in claiming that the Examiner's positions are still based on speculation is absurd. Initially, the Examiner had effectively taken official notice that the enhancements emphasized by Applicant were expected because they are so widely recognized. However, upon being asked to provide specific teachings that support his assertions, the Examiner produced the *Caradori*, *Eguchi*, *Burns*, *Canpoint*, and *Lutz* disclosures and could have cited numerous additional references but limited his expansion on the prior art to these in the name of brevity.

As for the idea that a suggestion of better solubility does not lend necessarily to the notion that filler concentrations exceeding 20% are possible, the Examiner agrees but the claims don't stipulate this level of doped metal oxide incorporation. Further, the Examiner suspects that, if this concept were to be searched, there would be more than a few documented compositions comprising a liquid silicone host and treated filler added in an amount comparable to those used in Applicant's examples.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

April 1, 2008

/Marc S. Zimmer/

Primary Examiner, Art Unit 1796

Application Number 	Application/Control No. 10/084,336		Applicant(s)/Patent under Reexamination KERNER ET AL.
	Examiner MARC S. ZIMMER		Art Unit 1796